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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

VIKTOR BROST et al

Serial No. 09/837,072

Filed April 18, 2001

#17  
JH  
5-21-03

) HEADER-LESS VEHICLE RADIATOR  
)  
Group Art Unit 3743  
)  
Examiner Tho V. Duong  
)

RESPONSE

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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MAY 20 2003

TECHNOLOGY CENTER R3700

Sir:

This is in response to the Office Action dated April 18, 2003.

The restriction requirement set forth on page 2 of the Office Action  
is respectfully but strongly traversed.

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37 CFR 1.8  
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 12, 2003.

Signature: Karen Sanderson

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In the first place, the matter of election or divisibility has previously been considered in this case. In the Office Action dated December 5, 2001, an election of species requirement was made; and the Applicants elected a species without traverse at that time. It would seem that if a divisional requirement was also justified in the case, it would have been made at that time, but it was not.

Two Office Actions on the merits were then rendered on February 14, 2002 and October 1, 2002 with a further Advisory Action rendered on November 5, 2002, all related to claims 1, 2 and 11-13, the claims that the Examiner now seeks to separate. Again, it would seem that if a division requirement was appropriate, it should have been set forth in one of those Office Actions, but it was not.

In fact, only after an appeal was taken, and a brief filed, was the restriction requirement rendered. In the meantime, the Applicants had incurred substantial expense in prosecuting claims 1, 2 and 11-13 which would not have been the case had some of those claims been withdrawn from consideration as a result of a timely and proper divisional requirement. Indeed, it would appear that the belated division requirement is made only to allow the Examiner to minimize his effort in responding to Applicants' Appeal Brief; and it is submitted that at this late stage in the prosecution, after the expenditures of substantial sums in prosecuting all of claims 1, 2 and 11-13, that is manifestly unfair.

Furthermore, it is noted that the present election requirement considers claims 11-13 as one group and claims 1 and 2 as a second group. At the same time, on page 4 of the Appeal Brief, Applicants admit that claims 1, 2 and 11 stand as a group. That is to say, the same are not patentably distinct. And since the Examiner has considered that claims 12 and 13 are not distinct from claim 11, it follows that the invention specified by claims 1, 2 and 11-13 are so interrelated that a restriction requirement is not proper.

In contrast to the foregoing facts that clearly indicate the impropriety of the restriction requirement, the Examiner has merely stated that the radiator as claimed can be made by a process such as a molding process and that the step of assembling the radiator can be carried out after the step of adapting one end of the tube.

Anyone skilled in a variety of arts, including the molding arts, would readily recognize that a radiator core including a plurality of tubes extending to a collecting tank, and having layers of fins between the tubes is incapable of being molded according to the present state of the art because the form is simply too complex. Cavities in the tubes run along the length of the tube while the spaces between layers of fins run in the opposite direction. Moreover, how collecting tanks could be molded over the ends of the core and still form the interior of the tubes and provide a fluid tight apparatus, which a heat exchanger must necessarily be, is simply impossible. The fact that the

step of assembling the radiator can be carried out after the step of adapting one end of the tube is not only true, it is a must because the tube end cannot be adapted after the radiator core is fully assembled. But that has no bearing on whether a molding process could be used to form the radiator and does not distinguish the method from the apparatus.

As a consequence, the Examiner's example purporting to show distinctness between the two inventions fails miserably because it does not take into account the impossibility of using a molding method and erroneously relies on a sequence of steps that is totally irrelevant to the issue. Accordingly, it is urged that the restriction requirement is improper and ought to be withdrawn.

Purely to satisfy the rules, and in the event the restriction requirement is not withdrawn either by the Examiner on reconsideration or on a subsequent petition, the Applicants elect the apparatus claims, namely claims 1 and 2 for further prosecution herein.

As a separate matter, Applicants protest the Examiner's comments spanning pages 3 and 4 of the Office Action relating to the duty to disclose. Specifically, the Examiner has stated "a co-pending application, which has been issued on February 4, 2003 as Patent No. 6,513,585 B2, was not notified to the Examiner" is manifestly incorrect. It is to be particularly noted that the amendment characterized as Amendment "A" and filed under certificate of

mailing dated January 2, 2002, contains the following language in the Remarks on page 5 thereof.

The Examiner's attention is further directed to the existence of commonly assigned application Serial No. 09/821,214 naming the same inventors, inventors Brost and Lamich, as inventors in that case as well. As of this date, to applicants' knowledge, the co-pending application has been assigned to Art Unit 3743, but the identity of the Examiner in that Art Unit is not known. The co-pending application should be closely checked to avoid any question of conflict of claims.

Thus, Serial No. 09/821,214 was called to the Examiner's attention and, in fact, it was this application that resulted in Patent 6,513,585 B2. Consequently, there was notification to the Examiner, including an indication of the location of the file within the office, and should the Examiner had read the foregoing disclosure of the Applicants, it would have been an easy matter to look up the file and check it. Even had the Examiner not wanted to take the time to look up the file, he should have notified Applicants to provide a copy of the file which Applicants would have readily done.

In any event, the statement regarding duty of disclosure is misleading at best and should be deleted from the record and a withdrawal of the Examiner's criticism on this basis, in writing and on the record, is solicited.

As this response is being filed under Rule 111, a Supplemental Appeal Brief (and the additional unwarranted expense associated therewith) is not necessary.

In summary, withdrawal of the ill-advised, improper and untimely division requirement is solicited. In addition, a statement on the record to the effect that the statement that the Applicants failed to direct the Examiner's attention to the co-pending application was in error is solicited.

The passing of the case to issue is believed to be in order.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,  
CLARK & MORTIMER

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May 12, 2003

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